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**TRANSMITTAL OF APPEAL BRIEF**  
(IN TRIPLICATE)

Docket No. (Optional): **52308-1190**

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5/27/05

Stephanie Riley

Signature – Stephanie Riley

In re Application of  
**Alan Derek Dean**

Application Number  
**09/815,760**

Filed  
**3/23/01**

For  
**System for Constructing Electronic Mail Addresses**

Group Art Unit  
**2154**

Examiner  
**Haresh N. Patel**

Confirmation No.:  
**7939**

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on April 22, 2005

The fee for this Appeal Brief is (37 CFR 1.17(c))

\$ 250.00

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.17(a)-(d) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

- |                          |                                  |           |
|--------------------------|----------------------------------|-----------|
| <input type="checkbox"/> | One month (37 CFR 1.17(a)(1))    | \$ 60.00  |
| <input type="checkbox"/> | Two months (37 CFR 1.17(a)(2))   | \$ 215.00 |
| <input type="checkbox"/> | Three months (37 CFR 1.17(a)(3)) | \$ 490.00 |
| <input type="checkbox"/> | Four months (37 CFR 1.17(a)(4))  | \$ 765.00 |

☐ The extension fee has already been filed in this application.

☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that the applicant has inadvertently overlooked the need for a petition and fee for extension of time.

**Method of Payment:**

- ☒ Payment is enclosed as follows:
- ☐ A check in the amount of \_\_\_\_\_ enclosed.
  - ☒ Payment by credit card. Form PTO-2038 is attached in the amount of 250.00
  - ☐ The Commissioner is authorized to charge \_\_\_\_\_ to a Deposit Account
  - ☒ The Commissioner is hereby authorized to charge any deficiencies in fees, or credit any overpayment to Deposit Account No. 20-0778. A duplicate copy is enclosed.

**Warning: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

5/27/05

Date

Scott A. Horstemeyer  
Scott A. Horstemeyer, Reg. No. 64,183



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:	)	Group Art Unit: 2154
	)	
Alan Derek Dean	)	Examiner: Haresh N. Patel
	)	
Serial No.: 09/815,760	)	Confirmation No.: 7939
	)	
Filed: 3/23/01	)	Docket No.: 052308-1190
	)	
For: <b>SYSTEM FOR CONSTRUCTING</b>	)	
<b>ELECTRONIC MAIL</b>	)	
<b>ADDRESSES</b>	)	

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Stephanie Riley  
Signature - Stephanie Riley

**APPEAL BRIEF UNDER 37 C.F.R. §1.192**

Mail Stop Appeal Brief - Patents  
Commissioner of Patents and Trademarks  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

This is an appeal from the decision of Examiner Haresh Patel, Group Art Unit 2154, mailed January 24, 2005 (and the Advisory Action mailed April 14, 2005), finally rejecting claims 1 - 20 of the above-referenced application and making the rejection FINAL.

## **I. REAL PARTY IN INTEREST**

The real party in interest of the instant application is Alan Derek Dean, an individual having his residence in Essex, United Kingdom.

## **II. RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences.

## **III. STATUS OF THE CLAIMS**

Claims 1-20 are pending in this application. The FINAL Office Action has rejected independent claims 1 and 7 and dependent claims 2, 4, 8 and 10 as allegedly being anticipated by U.S. Patent No. 6,125,369 to Wu (“*Wu*”). The FINAL Office Action also rejected independent claims 1 and 7 and dependent claims 2 – 5, 8 – 11, 13, 15, 17 and 19 as allegedly being anticipated by U.S. Patent No. 6,430,405 to Jambhekar (“*Jambhekar*”). The FINAL Office Action has rejected claims 6, 12, 14, 16, 18 and 20 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Jambhekar* in view of Official Notice. The FINAL Office Action has rejected dependent claims 3, 5 – 6, 9 – 13, 15 – 16 and 20 under 35 U.S.C. §112, second paragraph, as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. For the reasons set forth herein, Applicant submits that these rejections are misplaced and should be overturned by the Board.

## **IV. STATUS OF AMENDMENTS**

No amendments have been made or requested to any of the claims after the FINAL Office Action, and all amendments submitted or requested before the mailing of the FINAL Office

Action have been entered. A copy of the current claims is attached hereto as Appendix A.

## **V. SUMMARY OF CLAIMED SUBJECT MATTER**

The present application is directed to a system for generating a set of standardized electronic mailing addresses (FIG. 3). In accordance with the embodiment of independent claim 1, instructions for generating a set of standardized electronic mail addresses are operable to provide a personal name code indicative of the name of a person (FIG. 3, "NAME CODE GENERATOR.") Additionally, a location code is provided indicative of a known location of the person. The instructions further include generating an electronic mail address for the person based on the personal name code and the location code (FIG. 3, "ADDRESS GENERATOR.") The instructions further include providing a database (FIG. 3, "DATABASE") of the electronic mail addresses for a plurality of persons at one or more locations.

In accordance with the embodiment of claim 7, the system for generating a set of standardized electronic mail addresses includes logic configured to generate a personal name code indicative of the name of a person (FIG. 3, "NAME CODE GENERATOR.") Further, the system includes logic configured to generate a location code indicative of a known location of the person (FIG. 3, "LOCATION CODE GENERATOR.") Additionally, the system includes logic configured to generate an electronic mail address for the person based on the personal name code and the location code, (FIG. 3, "ADDRESS GENERATOR") and logic configured to provide a database ("FIG. 3, "DATABASE CREATOR" and "DATABASE") of the electronic mail addresses for a plurality of persons at one or more locations.

The personal name code may, for example, include a portion of a person's family name. The location code could be, for example, a postal code (e.g., zip code), for a telephone area code.

Embodiments may allow, for example, electronic mail addresses to be constructed and indexed so as to provide the easy location by a combination of some or all of a family name, forename, district, telephone area code, or for attachment of any amount of information relating to the address.

In some embodiments, one or more structured email addresses are generated for each individual in a country, geographic region, or state to which any number of subsidiary addresses can be attached, including existing electronic mail addresses.

The provided embodiments may, for example, allow for the production of a directory of electronic mail addresses for commercial trade service or professional requirements.

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

Independent claims 1 and 7, and dependent claims 4 and 10, were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by *Wu*.

Independent claims 1 and 7, and dependent claims 4 and 10, were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by *Jambhekar*.

Dependent claims 6, 12, 16, and 20 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Jambhekar* in view of Official Notice.

Dependent claims 3, 5, 6, 9 – 13, 15 – 16 and 20 were rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention.

## VII. ARGUMENT

### I. General Remarks Related to the §102 and §103 Rejections

Although Applicant addresses the §102 and §103 rejections of each of claims 1 – 20 individually below, Applicant believes a brief summary of the general differences between *Wu* or *Jambhekar* and claims 1 – 20 may be helpful.

The “Response to Arguments” in the FINAL Office Action apparently reiterates a number of alleged correlations between *Wu* and claims 1, 4, 7, and 10. However, Applicant submits that these alleged correlations are apparently misguided and/or overly broad, potentially showing a fundamental misunderstanding of either the cited art or Applicant’s claims 1, 4, 7, and 10.

For example, independent claim 1 is directed to a “program storage device readable by a machine and encoding a program of instructions for *generating a set of standardized electronic mail addresses*.” Furthermore, claim 1 recites that the instructions “*generate an electronic mail address*.” However, at most, *Wu* discloses “storing” email addresses. *Wu* simply does not disclose “generating” any email addresses at all. Even in its broadest sense, “storing” an email address is not equivalent to “generating” an electronic mail address.

A similar misapplied rejection is apparently used, for example, in the rejection of claims 1, 4, 7, and 10 as anticipated by the newly cited reference, *Jambhekar*. However, *Jambhekar* appears to be equally non-applicable. That is, at most, *Jambhekar* discloses “storing” email addresses. *Wu* simply does not disclose “generating” any email addresses at all. Even in its broadest sense, “storing” an email address is not equivalent to “generating” an electronic mail address.

These, and other distinctions are specifically addressed with respect to each of the rejected claims in more detail below.

## **II. Claims 1, 4, 7, and 10 are Patentable Over *Wu***

The FINAL Office Action rejects claims 1, 4, 7, and 10 under 35 U.S.C. §102(b) as allegedly being anticipated by *Wu*. For at least the reasons set forth below, the rejection should be overturned and the claims allowed.

### ***Independent Claim 1***

The Applicant respectfully submits that claim 1 patently defines over *Wu* for at least the reason that *Wu* fails to disclose or otherwise teach “*generating an electronic mail address for said person based on said personal name code and said location code*” as recited in claim 1.

Unlike the device for generating a set of standardized electronic mail addresses of claim 1, *Wu* does not appear to disclose generating email addresses at all. Further, Applicant has reviewed the entirety of *Wu*, including the portions highlighted in the FINAL Office Action, and has performed a computer-based textual search of *Wu* for the terms “email,” “e-mail,” “mail,” “electronic mail,” and “address” and have not discovered any disclosure related to “an electronic mail address” or “generating an electronic mail address” as recited in claim 1. Rather, *Wu* is apparently directed to synchronizing object stores, such as databases, on different computers that are only occasionally connected for data communications computers. (Col. 1, lines 13-15).

As an example, the FINAL Office Action alleges that: “*Wu* clearly discloses use of data bases (e.g., Microsoft Outlook 97, Schedule+ program, PIM, col. 3, lines 19-30, with information device, e.g., col., 3, lines 19-30) to generate address (e.g., contact information,

such as addresses, phone numbers, etc. col., 3 lines 31 – 41) for the user based on the user name code (e.g., name of a user, col., 18, lines 33-39) and said location code.” (FINAL Office Action, pg. 2). Additionally, the FINAL Office Action alleges *Wu* discloses “generating a set of standardized (i.e. identical / consistent / uniform , col., 3, lines 31 – 41) addresses.” (FINAL Office Action, pg. 2).

However, col. 3, lines 31 – 41 of *Wu* (allegedly disclosing “generating”) discloses:

The Schedule+ program, available from Microsoft Corporation of Redmond, Wash., is one example of a PIM that can be configured in accordance with the invention. Microsoft Outlook 97 is another example. The primary object store, also referred to as a desktop object store, is ***configured to store a plurality of individual records or objects***, each comprising a plurality of fields or properties. In Schedule+, for example, there are objects of different types, corresponding to appointments, contacts, and tasks. Each object comprises a plurality of properties, such as addresses, phone numbers, task descriptions, etc.

(*Emphasis added*). *Wu* is directed to “a system for synchronizing object instances between first and second object stores.” (*Emphasis added*, Abstract). Storing and/or synchronizing is not equivalent to “generating.” Accordingly, for at least the reason that *Wu* does not disclose “generating” at all, *Wu* also does not disclose “***generating an electronic mail address for said person based on said personal name code and said location code***” as recited in claim 1.

Accordingly, rejection of claim 1 should be overturned for at least the reason that *Wu* fails to disclose or otherwise teach “***generating an electronic mail address for said person based on said personal name code and said location code***” as recited in claim 1.

Furthermore, because independent claim 1 is allowable over *Wu*, dependent claims 2 – 6 are allowable as a matter of law for at least the reason they contain all the features and elements of independent claim 1, from which they depend.

#### ***Dependent Claim 4***



Applicant submits that the rejection to dependent claim 4 is rendered moot in light of any of the arguments made above and, therefore, claim 4 is allowable as a matter of law for at least the additional reason that claim 4 contains all features and elements of its corresponding independent claim.

Furthermore, Applicant respectfully submits that claim 4 patently defines over *Wu* for at least the reason that *Wu* fails to disclose or otherwise teach that “*one or more structured addresses are created for each individual in a country, geographic region or state*” as recited in dependent claim 4.

The FINAL Office Action alleges that *Wu* discloses that “one or more structured addresses are created for each individual in a country, geographic region or state (e.g., city, col., 18, lines 33 – 39).” (FINAL Office Action, pg. 7).

However, *Wu* discloses only:

A database consists of a set of records, each containing one or more data fields called properties. For example, a Contacts application would contain a database of address records, and the properties of each record might consist of a name, street address, city, state, zip code, and telephone number. The maximum size of a record is 128K. The maximum property size is 64K.  
(Col. 18, lines 33 – 39).

Accordingly, unlike claim 4, Applicant submits that *Wu* does not disclose that one or more structured addresses are “*created*” at all. Furthermore, structured addresses are not created “for *each individual* in a country, geographic region, or state” as recited in claim 4.

Accordingly, the rejection of claim 4 should be overturned for at least the reason that *Wu* fails to disclose or otherwise teach that “*one or more structured addresses are created for each individual in a country, geographic region or state*” as recited in claim 4.

#### ***Independent Claim 7***

Applicant respectfully submits that claim 7 patently defines over *Wu* for at least the reason that *Wu* fails to disclose or otherwise teach “*logic configured to generate an electronic mail address for said person based on said personal name code and said location code*” as recited in claim 7.

Unlike the system for generating a set of standardized electronic mail addresses of claim 7, *Wu* does not appear to disclose generating email addresses at all. Further, Applicant has reviewed the entirety of *Wu*, including the portions highlighted in the Office Action, and has performed a computer-based textual search for the terms “email,” “e-mail,” “mail,” “electronic mail,” and “address” and have not discovered any disclosure related to “an electronic mail address” or “logic configured to generate an electronic mail address” as recited in claim 7. Rather, *Wu* is apparently directed to synchronizing object stores, such as databases, on different computers that are only occasionally connected for data communications. (Col. 1, lines 13-15).

As an example, the Office Action alleges that: “*Wu* clearly discloses use of data bases (e.g., Microsoft Outlook 97, Schedule+ program, PIM, col. 3, lines 19-30, with information device, e.g., col., 3, lines 19-30) to generate address (e.g., contact information, such as addresses, phone numbers, etc. col., 3 lines 31 – 41) for the user based on the user name code (e.g., name of a user, col., 18, lines 33-39) and said location code.” (FINAL Office Action, pg. 2). Additionally, the FINAL Office Action alleges *Wu* discloses “generating a set of standardized (i.e. identical / consistent / uniform , col., 3, lines 31 – 41) addresses.” (FINAL Office Action, pg. 2).

However, col. 3, lines 31 – 41 of *Wu* (allegedly disclosing “generating”) discloses:

The Schedule+ program, available from Microsoft Corporation of Redmond, Wash., is one example of a PIM that can be configured in accordance with the

invention. Microsoft Outlook 97 is another example. The primary object store, also referred to as a desktop object store, is ***configured to store a plurality of individual records or objects***, each comprising a plurality of fields or properties. In Schedule+, for example, there are objects of different types, corresponding to appointments, contacts, and tasks. Each object comprises a plurality of properties, such as addresses, phone numbers, task descriptions, etc.

(*Emphasis added*). Wu is directed to “a system for synchronizing object instances between first and second object stores.” (*Emphasis added*, Abstract). Storing and/or synchronizing is not equivalent to “generating.” Accordingly, for at least the reason that Wu does not disclose “generating” at all, Wu also does not disclose “***logic configured to generate an electronic mail address for said person based on said personal name code and said location code***” as recited in claim 7.

Accordingly, the rejection of claim 7 should be overturned for at least the reason that Wu fails to disclose or otherwise teach “***logic configured to generate an electronic mail address for said person based on said personal name code and said location code***” as recited in claim 7. Furthermore, because independent claim 7 is allowable over Wu, dependent claims 8 – 20 are allowable as a matter of law for at least the reason they contain all the features and elements of independent claim 7, from which they depend.

### ***Dependent Claim 10***

The Applicant submits that the rejection to dependent claim 10 is rendered moot in light of any of the arguments made above and, therefore, claim 10 is allowable as a matter of law for at least the reason that claim 10 contains all features and elements of its corresponding independent claim.

Furthermore, Applicant respectfully submits that claim 10 patently defines over Wu for at least the additional reason that Wu fails to disclose or otherwise teach that the “***logic***

*configured to generate an electronic mail address is operable to create one or more structured addresses for each individual in a country, geographic region or state”* as recited in dependent claim 10.

The FINAL Office Action alleges that *Wu* discloses the “one or more structured addresses are created for each individual in a country, geographic region or state (e.g., city, col., 18, lines 33 – 39).” (FINAL Office Action, pg. 7).

However, *Wu* discloses only:

A database consists of a set of records, each containing one or more data fields called properties. For example, a Contacts application would contain a database of address records, and the properties of each record might consist of a name, street address, city, state, zip code, and telephone number. The maximum size of a record is 128K. The maximum property size is 64K.  
(Col., 18, lines 33 – 39).

Accordingly, unlike claim 10, Applicant submits that *Wu* does not disclose that one or more structured addresses are “*created*” at all. Furthermore, structured addresses are not created “for *each individual* in a country, geographic region, or state” as recited in claim 10.

Accordingly, the rejection of claim 10 should be overturned for at least the reason that *Wu* fails to disclose or otherwise teach that the “*logic configured to generate an electronic mail address is operable to create one or more structured addresses for each individual in a country, geographic region or state*” as recited in claim 10.

### III. Claims 1, 4, 7 and 10 are Patentable Over *Jambhekar*

The FINAL Office Action rejects claims 1, 4, 7 and 10 under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent No. 6,430,405 to *Jambhekar* (“*Jambhekar*”). For at least the reasons set forth below, the rejection should be overturned and the claims allowed.

***Independent Claim 1***

Applicant respectfully submits that claim 1 patently defines over *Jambhekar* for at least the reason that *Jambhekar* fails to disclose or otherwise teach instructions operable to “*generate an electronic mail address for said person based on said personal name code and said location code*” as recited in claim 1.

Unlike the device for generating a set of standardized electronic mail addresses of claim 1, Applicant has reviewed the entirety of *Jambhekar*, including the portions highlighted in the Office Action, and has not discovered any disclosure related to “generating an electronic mail address” as recited in claim 1. Rather, *Jambhekar* is apparently directed to “radio communication devices having functional icons associated with [sic] stored directory number.” (Col. 1, lines 12-14).

As an example, the FINAL Office Action alleges that “*Jambhekar* teaches a program storage device readable by a machine and encoding a program of instructions / a system for generating a set of standardized electronic mail addresses (e.g., figure 5 –1 7, col., 2, lines 48 – 55, col., 5., lines 38 – 58),” and “logic configured to generate an electronic mail address for said person based on said personal name code and said location code (e.g. figures 5-3, 5-12, 5-17, col., 5, lines 38 - 58, col. 6, lines 11- 28).” (FINAL Office Action, pgs. 7-8).

However, col. 2, lines 48 – 55; col. 5, lines 38 – 58; and col. 6, lines 11 – 28 of *Jambhekar* (allegedly disclosing “generating”) discloses only:

When the moveable housing element is in the open or extended position, the radio communication device has a second set of user functions including functional icons associated with radiotelephone functions, advanced radiotelephone functions, and messaging functions such as electronic mail, faxing, and short message service. The functional icons displayed on the screen can be accessed touching the screen with a stylus or writing implement. (Col. 2, lines 48 – 55); and

***Turning now to FIG. 4, the operation of storing directory numbers and associated icons in a phone book directory of the radio communication device is shown.*** For ease of understanding, exemplary images associated with a given step which could be displayed on the screen will be shown as necessary. After entering the main menu (MENU) (FIG. 4-1), the phone book entry mode is selected (FIG. 4-2) at a step 402. Various information fields can then be entered at a step 404. ***Among other information, the name (commonly called alpha tag), title, company, address and various directory numbers including phone or fax and other addresses including e-mail and SMS addresses may be entered.*** When the phone book entry mode is selected, a prompt for entering a name with a QWERTY keyboard arrangement is preferably shown in the touch screen display to enter the name (FIG. 4-3). While the QWERTY keyboard is shown in the display, handwriting recognition software such as QuickPrint.TM. available from Lexicus Corporation could be used to enter the name or other information according to the present invention. After the name is entered, an address prompt is shown in the display (FIG. 4-4).

(*Emphasis added*, col. 5, lines 38 – 58); and

Turning now to FIG. 5, the operation of selecting an entry of the phone book directory is shown. A user has the option of entering the phone book directory by selecting the phone book icon on the display, or selecting a recall (RCL) option on the display to directly enter a memory location of the phone directory (FIG. 5-1). If the user selects the recall option at a step 502, the user then selects the numerical location associated with the entry (FIG. 5-2) by entering the memory location number and selecting the FIND key at a step 504, and the name and phone number associated with that memory location is displayed (FIG. 5-3) at a step 505. Additional information associated with that entry could also be displayed as desired. Alternatively, the predetermined memory location may be displayed with name and icon associated with the predetermined memory location being shown, and with sequentially adjacent memory locations also being shown (FIG. 5-4). This option would enable the user to cursor through sequentially adjacent entries if desired.

(col. 6, lines 11 – 28). Thus, at most, *Jambhekar* discloses “storing” information by “entering” an email address. “Storing” and/or “entering” simply is not equivalent to

“generating” as in independent claim 7. Accordingly, for at least the reason that *Jambhekar* does not disclose “generating” at all, *Jambhekar* also does not disclose logic configured to “*generate an electronic mail address for said person based on said personal name code and said location code*” as recited in claim 1.

Accordingly, the rejection of claim 1 should be overturned for at least the reason that *Jambhekar* fails to disclose or otherwise teach instructions operable to “*generate an electronic mail address for said person based on said personal name code and said location code*” as recited in claim 1.

#### ***Dependent Claim 4***

The Applicant submits that the rejection to dependent claim 4 is rendered moot in light of any of the arguments made above and, therefore, claim 4 is allowable as a matter of law for at least the reason that claim 4 contains all features and elements of its corresponding independent claim 1.

Furthermore, Applicant respectfully submits that claim 4 patently defines over *Jambhekar* for at least the reason that *Jambhekar* fails to disclose or otherwise teach that “*one or more structured addresses are created for each individual in a country, geographic region or state*” as recited in dependent claim 4.

The FINAL Office Action alleges that *Jambhekar* discloses the “one or more structured addresses are created for each individual in a country, geographic region or state (e.g., col., 2, lines 40 – 55).” (FINAL Office Action, pg. 8).

However, *Jambhekar* discloses only:

Additionally, the radio communication device preferably has a keypad disposed in the moveable housing element. The keys have a first portion

exposed through corresponding apertures in the moveable housing element, such that when a user depresses the first portion of the keys, a second portion of the key provides pressure against the touch screen display for activating a first set of user functions. The provided pressure activates a portion of the touch screen display. When the moveable housing element is in the open or extended position, the radio communication device has a second set of user functions including functional icons associated with radiotelephone functions, advanced radiotelephone functions, and messaging functions such as electronic mail, faxing, and short message service. The functional icons displayed on the screen can be accessed touching the screen with a stylus or writing implement.

(Col., 2, lines 40 – 55). Applicant fails to see the alleged correlation between the above text and the claimed features. The recitation that the radio communication device of *Jambhekar* has a user function of “electronic mail” is hardly equivalent to the feature that “one or more structured addresses are created for each individual in a country, geographic region or state” as recited in claim 4.

Accordingly, unlike claim 4, Applicant submits that *Jambhekar* does not disclose that one or more structured addresses are “*created*” at all. Furthermore, structured addresses are not created “for *each individual* in a country, geographic region, or state” as recited in claim 4.

Accordingly, the rejection of claim 4 should be overturned for at least the reason that *Jambhekar* fails to disclose or otherwise teach that “*one or more structured addresses are created for each individual in a country, geographic region or state*” as recited in claim 4.

#### ***Independent Claim 7***

Applicant respectfully submits that claim 7 patently defines over *Jambhekar* for at least the reason that *Jambhekar* fails to disclose or otherwise teach “*logic configured to generate an electronic mail address for said person based on said personal name code and said location code*” as recited in claim 7.



Unlike the device for generating a set of standardized electronic mail addresses of claim 7, Applicant has reviewed the entirety of *Jambhekar*, including the portions highlighted in the FINAL Office Action, and has not discovered any disclosure related to “generating an electronic mail address” as recited in claim 7. Rather, *Jambhekar* is apparently directed to “radio communication devices having functional icons associated with [sic] stored directory number.” (Col. 1, lines 12-14).

As an example, the Office Action alleges that “Jambhekar teaches a program storage device readable by a machine and encoding a program of instructions / a system for generating a set of standardized electronic mail addresses (e.g., figure 5 –1 7, col., 2, lines 48 – 55, col., 5., lines 38 – 58),” and “logic configured to generate an electronic mail address for said person based on said personal name code and said location code (e.g. figures 5-3, 5-12, 5-17, col., 5, lines 38 - 58, col. 6, lines 11- 28).” (FINAL Office Action. pgs. 7-8).

However, col. 2, lines 48 – 55; col. 5, lines 38 – 58; and col. 6, lines 11 – 28 of *Jambhekar* (allegedly disclosing “generating”) discloses:

When the moveable housing element is in the open or extended position, the radio communication device has a second set of user functions including functional icons associated with radiotelephone functions, advanced radiotelephone functions, and messaging functions such as electronic mail, faxing, and short message service. The functional icons displayed on the screen can be accessed touching the screen with a stylus or writing implement.

(Col. 2, lines 48 – 55); and

***Turning now to FIG. 4, the operation of storing directory numbers and associated icons in a phone book directory of the radio communication device is shown.*** For ease of understanding, exemplary images associated with a given step which could be displayed on the screen will be shown as necessary. After entering the main menu (MENU) (FIG. 4-1), the phone book entry mode is selected (FIG. 4-2) at a step 402. Various information fields can then be entered at a step 404. ***Among other information, the name (commonly called alpha tag), title, company, address and various directory numbers including phone or fax and other addresses including e-mail and SMS addresses may be***

*entered*. When the phone book entry mode is selected, a prompt for entering a name with a QWERTY keyboard arrangement is preferably shown in the touch screen display to enter the name (FIG. 4-3). While the QWERTY keyboard is shown in the display, handwriting recognition software such as QuickPrint.TM. available from Lexicus Corporation could be used to enter the name or other information according to the present invention. After the name is entered, an address prompt is shown in the display (FIG. 4-4).

(*Emphasis added*, col. 5, lines 38 – 58); and

Turning now to FIG. 5, the operation of selecting an entry of the phone book directory is shown. A user has the option of entering the phone book directory by selecting the phone book icon on the display, or selecting a recall (RCL) option on the display to directly enter a memory location of the phone directory (FIG. 5-1). If the user selects the recall option at a step 502, the user then selects the numerical location associated with the entry (FIG. 5-2) by entering the memory location number and selecting the FIND key at a step 504, and the name and phone number associated with that memory location is displayed (FIG. 5-3) at a step 505. Additional information associated with that entry could also be displayed as desired. Alternatively, the predetermined memory location may be displayed with name and icon associated with the predetermined memory location being shown, and with sequentially adjacent memory locations also being shown (FIG. 5-4). This option would enable the user to cursor through sequentially adjacent entries if desired.

(col. 6, lines 11 – 28). Thus, at most, *Jambhekar* discloses “storing” information by “entering” an email address. “Storing” and/or “entering” simply is not equivalent to “generating” as in independent claim 7. Accordingly, for at least the reason that *Jambhekar* does not disclose “generating” at all, *Jambhekar* also does not disclose logic configured to “*generate an electronic mail address for said person based on said personal name code and said location code*” as recited in claim 7.

Accordingly, the rejection of claim 7 should be overturned for at least the reason that *Jambhekar* fails to disclose or otherwise teach “*logic configured to generate an electronic mail address for said person based on said personal name code and said location code*” as recited in claim 7.

### ***Dependent Claim 10***

Applicant submits that the rejection to dependent claim 10 is rendered moot in light of any of the arguments made above and, therefore, claim 10 is allowable as a matter of law for at least the reason that claim 10 contains all features and elements of its corresponding independent claim.

Furthermore, Applicant respectfully submits that claim 10 patently defines over *Jambhekar* for at least the reason that *Jambhekar* fails to disclose or otherwise teach that that the “*logic configured to generate an electronic mail address is operable to create one or more structured addresses for each individual in a country, geographic region or state*” as recited in dependent claim 10.

The Office Action alleges that *Jambhekar* discloses the “one or more structured addresses are created for each individual in a country, geographic region or state (e.g., col., 2, lines 40 – 55).” (Office Action, pg. 8).

However, *Jambhekar* discloses only:

Additionally, the radio communication device preferably has a keypad disposed in the moveable housing element. The keys have a first portion exposed through corresponding apertures in the moveable housing element, such that when a user depresses the first portion of the keys, a second portion of the key provides pressure against the touch screen display for activating a first set of user functions. The provided pressure activates a portion of the touch screen display. When the moveable housing element is in the open or extended position, the radio communication device has a second set of user functions including functional icons associated with radiotelephone functions, advanced radiotelephone functions, and messaging functions such as electronic mail, faxing, and short message service. The functional icons displayed on the screen can be accessed touching the screen with a stylus or writing implement.

(Col., 2, lines 40 – 55). Applicant fails to see the alleged correlation between the above text and the claimed features. The recitation that the radio communication device of *Jambhekar* has a user function of “electronic mail” is hardly equivalent to the feature that “one or more

structured addresses are created for each individual in a country, geographic region or state” as recited in claim 10.

Accordingly, unlike claim 10, Applicant submits that *Jambhekar* does not disclose that one or more structured addresses are “*created*” at all. Furthermore, structured addresses are not created “for *each individual* in a country, geographic region, or state” as recited in claim 10.

Accordingly, the rejection of claim 10 should be overturned for at least the reason that *Jambhekar* fails to disclose or otherwise teach that the “logic configured to generate an electronic mail address is operable to create one or more structured addresses for each individual in a country, geographic region or state” as recited in claim 10.

#### **IV. Dependent Claims 6, 12, 16, and 20 are Patentable Over the Proposed Combination of *Jambhekar* in View of Official Notice**

The FINAL Office Action rejects claims 6, 12, 16, and 20 under 35 U.S.C. §103(a) as allegedly being anticipated by *Jambhekar* in view of Official Notice. For at least the reasons set forth below, the rejection should be overturned and the claims allowed.

As an initial matter, Applicant submits that the rejection to dependent claims 6, 12, 16, and 20 is rendered moot in light of any of the arguments made above and, therefore, claims 6, 12, 16, and 20 are allowable as a matter of law for at least the reason that claims 6, 12, 16, and 20 contain all features and elements of their corresponding independent claim.

However, even further, Applicant agrees with the Office Action assertion that “*Jambhekar* does not specifically mention about attaching a unique identifier to the person’s electronic mail address and after determining that the electronic mail address is non-unique attaching an indicator.” (Office Action, pg. 9).

Furthermore, Applicant respectfully traversed the Official Notice taken in the FINAL Office Action reciting that “‘Official Notice’ is taken that both the concept and advantages of providing attaching [sic] a unique identifier to the person’s electronic mail address and after determining that the electronic mail address is non-unique attaching an indicator is well known and expected in the art.” (FINAL Office Action, pg. 9).

However, despite that none of the cited references disclose each and every element of claims 6, 12, 16, and 20, the FINAL Office Action has taken Official Notice of various claim limitations (and, apparently the motivation) as being “well-known.” The Manual of Patent Examining Procedure (MPEP) defines the standard for taking official notice. As provided in MPEP § 2144.03:

Official notice without documentary evidence to support an examiner’s conclusion is permissible only in some circumstances. While “official notice” may be relied on, these circumstances *should be rare when an application is under final rejection or action* under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are *capable of instant and unquestionable demonstration as being well-known*. As noted by the court in *In re Ahlert*, 424, F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be “capable of such instant and unquestionable demonstration as to defy dispute” (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

(*Emphasis added*). In the instant case, Applicant respectfully traverses the apparent allegation that “the concept and advantages of providing attaching [sic] a unique identifier to the person’s electronic mail address and after determining that the electronic mail address is non-unique attaching an indicator is well known and expected in the art” is capable of instant and unquestionable demonstration, and respectfully submits that one skilled in the art would not have known to include the features recited in claims 6, 12, 14, 16, 18, and 20 as alleged in the

Office Action. Thus, Applicant submits that the use of Official Notice, unsupported by documenting evidence, in the FINAL Office Action is not applied to the type of claim limitations contemplated by the MPEP. Furthermore, the failure of the FINAL Office Action or the Advisory Action to cite documentary evidence of the alleged obvious claim element in any of the references is evidence, in itself, that none is available. If Applicant is incorrect, however, Applicant respectfully requests that the appropriate support (which presumably would be readily available) be identified for the official notice that has been taken.

In conclusion, Applicant submits that the Official Notice taken with respect to claims 6, 12, 16, and 20 in the FINAL Office Action is improper. Further, for at least the reason that *Jambhekar* neither discloses instructions operable to “attach a unique identifier to the person’s electronic mail address” as recited in claim 6, nor logic “operable to attach a unique identifier to the person’s electronic mail address” as recited in claim 12, claims 6 and 12 are allowable over *Jambhekar*. Furthermore, for at least the reason that *Jambhekar* neither discloses the steps of “wherein upon determining that the electronic mail address generated is non-unique, generating the electronic mail address for the person by attaching an indicator to the electronic mail address” as recited in claim 16, nor “wherein upon determining that the electronic mail address generated is non-unique, generating the electronic mail address for the person by attaching an indicator to the electronic mail address” as recited in claim 20, claims 16 and 20 are allowable over *Jambhekar*.

Accordingly, for at least these reasons, the rejection of dependent claims 6, 12, 16, and 20 should be overturned and the claims allowed.

**V. Claims 3, 5, 6, 9-13, 15 – 16 and 20 Comply with 35 U.S.C. §112**

The FINAL Office Action rejects claims 3, 5, 6, 9-13, 15 – 16 and 20 under 35 U.S.C. §112, second paragraph, as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Applicant respectfully submits that each of claims 3, 5, 6, 9 – 13, 15 – 16 and 20 are not indefinite and fully comply with 35 U.S.C. §112 for at least the reasons set forth below.

***Claims 16 and 20***

As to claims 16 and 20, the FINAL Office Action alleges that the phrase “generating the electronic mail address for the person by attaching an indicator to the electronic mail address” (*Emphasis in Original*, FINAL Office Action, pg. 5) lacks antecedent basis. The FINAL Office Action further alleges that “since, independent claims 1 and 7, also contain ‘generating the electronic mail address’ limitation, it is not clear which ‘electronic mail address’ belongs to which ‘generating the electronic mail address’ limitation.” (FINAL Office Action, pg. 5).

Both dependent claims 16 and 20 recite: “wherein upon determining that the electronic mail address generated is non-unique, generating the electronic mail address for the person by attaching an indicator to the electronic mail address.” Applicant submits that the “electronic mail address” referenced in dependent claims 16 and 20 is the same “electronic email address” previously referenced in each of independent claims 1 and 7, respectively.

Accordingly, Applicant submits that claims 16 and 20 comply with §112. Thus, the rejection of claims 16 and 20 under §112 should be overturned.

***Claims 3, 5, 6, 9 – 13, and 15***

As to claims 3, 5, 6, 9 – 13, and 15, the FINAL Office Action alleges that the phrase “the person’s” lacks antecedent basis because “independent claims 1 and 7, contain multiple unrelated person [sic]” (FINAL Office Action, pg. 5).

Specifically, as to the §112 rejection of claims 3, 5 and 6, independent claim 1 includes “a person” on line 4, which is also referred to on line 5 as “the person” and “said person” on line 6. Independent claim 1 also refers to “a plurality of persons” on line 8. Each of dependent claims 3, 5, and 6, refer to (non-plural) “the person’s” or “the person,” which find antecedent support in independent claim 1, from which they depend. Similarly, as to the rejection of claims 9 – 13, and 15, independent claim 7 includes “a person” on line 4, which is also referred to on line 6 as “the person” and “said person” on line 7.

Independent claim 7 also refers to “a plurality of persons” on line 10. Each of dependent claims 9, 10, 11, 12, and 13 refer to (non-plural) “the person’s” or “the person,” which finds antecedent support in independent claim 7, from which they depend. Accordingly, Applicant submits that the rejection of claims 3, 5, 6, 9 – 13, and 15 under §112 is misplaced, and the rejection should be overturned.

The Advisory Action mailed April 4, 2005 indicates that:

In response to the Applicant’s remark, dated 3/23/05, “Applicant requests that the Examiner to [sic] more clearly suggest alternate language to overcome the 112 rejections, as limitations “a person (line 4 of independent claims 1 and 7)” and “a plurality of persons (line 8 of independent claim 1 and line 10 of independent claim 7)”, seems referring [sic] to an already referenced person. In response to the Applicant’s remark, [sic] limitation having prefix “a” refers [sic] to a new independent limitation. Hence, for limitations “a person” and “a plurality of persons”, person of “a person” limitation [sic] is not the same person as referred by “a plurality of persons” limitation. In order to refer to the previously [sic] defined (same) person, applicant is requested to consider proper prefixes [sic] for the dependent (referring) limitations. For example, limitation, “a plurality of items” can be referred by the “the plurality of items” or “said plurality of items”, in order to have the same (dependent) plurality of items referred [sic] in the claim. A single “item” of limitation, “a



plurality of items”, can be referred by “one of the plurality of items” or “one of said plurality of items”, in order to have the same (dependent) plurality of items referred in the claim. Limitations, “the person” and “said person” are dependent limitations, which can be use [sic] to refer [sic] independent limitation [sic] (i.e., either a “a plurality of persons” or “a person”) in the claim.

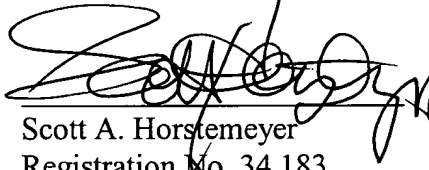
(Advisory Action, Continuation Sheet). Applicant appreciates the further explanation of the rejection of claims 3, 5, 6, 9 – 13 and 15 under §112.

Applicant maintains, however, that each of claims 3, 5, 6, 9 – 13 and 15 are clear as currently presented, and do not lack antecedent basis as alleged. However, should the rejection under §112 not be overturned, and all other issues resolved, Applicant is open to proposing an amendment that satisfies the suggestions provided in the Advisory Action and that does not alter the scope of the pending claims.

### **CONCLUSION**

Based upon the foregoing discussion, Applicant respectfully requests that the Examiner's FINAL rejection of claims 1-20 be overruled by the Board, and that the application be allowed to issue as a patent with all pending claims. No additional fees are believed to be due in connection with this Appeal Brief. If, however, any additional fees are deemed to be payable, you are hereby authorized to charge any such fees to deposit account No. 20-0778.

Respectfully submitted,



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## **APPENDIX A - CLAIMS**

1. A program storage device readable by a machine and encoding a program of instructions for generating a set of standardized electronic mail addresses, said instructions operable to:

provide a personal name code indicative of the name of a person;

provide a location code indicative of a known location of the person;

generate an electronic mail address for said person based on said personal name code and said location code; and

provide a database of said electronic mail addresses for a plurality of persons at one or more locations.

2. The program storage device according to claim 1, wherein the location code is a postal code, country specific address locator code, a telephone area code, or a region specific portion of a telephone number.

3. The program storage device according to claim 1, wherein the personal name code includes at least the person's family name.

4. The program storage device according to claim 1, wherein one or more structured addresses are created for each individual in a country, geographic region or state.

5. The program storage device according to claim 1, wherein one or more subsidiary addresses, including existing electronic addresses, are attached to the person's electronic mail address in the database.

6. The program storage device according to claim 1, wherein the instructions are further operable to:

attach a unique identifier to the person's electronic mail address.

7. A system for generating a set of standardized electronic mail addresses, including:

logic configured to generate a personal name code indicative of the name of a person;

logic configured to generate a location code indicative of a known location of the person;

logic configured to generate an electronic mail address for said person based on said personal name code and said location code; and

logic configured to provide a database of said electronic mail addresses for a plurality of persons at one or more locations.

8. A system according to claim 7, wherein the location code is a postal code, country specific address locator code, a telephone area code, or a region specific portion of a telephone number.

9. A system according to claim 7, wherein the personal name code includes at least a the person's family name.
10. A system according to claim 7, wherein the logic configured to generate an electronic mail address is operable to create one or more structured addresses for each individual in a country, geographic region or state associated with the person.
11. A system according to claim 7, wherein the logic configured to generate an electronic mail address is operable to attach one or more subsidiary addresses, including existing electronic addresses, to the person's electronic mail address in the database.
12. A system according to claim 7, wherein the logic configured to generate an electronic mail address is operable to attach a unique identifier to the person's electronic mail address.
13. The program storage device according to claim 1, wherein the instructions are further operable to:  
  
collect the name and the known location of the person from an information source.

14. The program storage device according to claim 1, wherein the instructions are further operable to:

provide the database of electronic mail addresses on-line.

15. The program storage device according to claim 14, wherein the instructions are further operable to:

locate the electronic mail address of the person in the database.

16. The program storage device according to claim 1, wherein the instructions are further operable to:

determine whether the electronic mail address generated for the person based on the personal name code and the location code is non-unique, and

wherein upon determining that the electronic mail address generated is non-unique, generating the electronic mail address for the person by attaching an indicator to the electronic mail address.

17. The system of claim 7, further including:

logic configured to collect the name and the known location of the person from an information source.

18. The system of claim 7, further including:

logic configured to provide the database of electronic mail addresses on-line.

19. The system of claim 18, further including:

logic configured to locate the electronic mail address of the person in the database.

20. The system of claim 7, further including:

logic configured to determine whether the electronic mail address generated for the person based on the personal name code and the location code is non-unique, and

wherein upon determining that the electronic mail address generated is non-unique, generating the electronic mail address for the person by attaching an indicator to the electronic mail address.

## **APPENDIX B – EVIDENCE**

None.



**APPENDIX C – RELATED PROCEEDINGS**

None.